



UNITED STATES  
PATENT AND  
TRADEMARK OFFICE

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JUL 28 2003

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. BOX 1450  
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GENAISANCE PHARMACEUTICALS  
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NEW HAVEN CT 06511

In re application of :  
Stephen B. Liggett :  
Serial No. : 09/856,803 : DECISION ON PETITION  
Filed : May 25, 2001 :  
Attorney Docket No.: MWH-0029US :

This is in response to applicants' petition, filed May 7, 2003 under 37 CFR 1.144, requesting withdrawal of the restriction requirement set forth by the examiner.

#### BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 371 as the National Stage of PCT/US99/27963, filed November 24, 1999, which claims priority to U.S. provisional application 60/109,886, filed November 25, 1998. The application, as filed with preliminary amendments, contained claims 1-21, 23 and 26-29. In a first Office action mailed September 20, 2002, the examiner set forth a restriction / lack of unity requirement under 35 U.S.C. 121 and 372 dividing the claims into 9 groups.

In the response filed October 21, 2002, applicant elected Group I, drawn to a method of genotyping the  $\beta_2$ AR gene, and further elected a group of polymorphic sites to be determined. Applicant traversed the restriction on essentially the same grounds presented in the instant petition. On January 7, 2003 the examiner mailed a first Office action on the merits. The examiner rejoined the claims of Group III with Group I, but otherwise maintained the restriction requirement and made it final.

#### DISCUSSION

In the petition, Applicants argue that Groups I, V and IX have unity of invention because they share the technical feature of determining the identity of a particular nucleotide pair in both copies of an individual's  $\beta_2$ AR gene. Applicant further argues that this technical feature is not found in the Emorine reference cited by the examiner in the original restriction requirement. This argument is not persuasive because the two Timmermann references cited in the Office action of January 7, 2003 each disclose determining said

nucleotide pair in both copies of the  $\beta_2$ AR gene. Therefore this method step is not a special technical feature within the meaning of 37 CFR 1.475(a).

**DECISION**

Applicant's petition is **DENIED** for the reasons set forth above.

The application will be forwarded to the examiner for consideration of the amendment filed July 8, 2003.

Any request for reconsideration or review of this decision must be made by a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with regard to this letter please contact Bruce Campell by letter addressed to the Director, Technology Center 1600, Washington, DC 20231, or by telephone at (703) 308-4205 or by facsimile transmission at (703) 746-5006.

John Doll  
Director, Technology Center 1600

